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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,028	12/23/2005	Eckhardt Lubke	ZAHFRI P802US	5557
20210 7590 08/21/2009 DAVIS & BUJOLD, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301				
EXAMINER				
PILKINGTON, JAMES				
ART UNIT		PAPER NUMBER		
3656				
MAIL DATE		DELIVERY MODE		
08/21/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/562,028

Applicant(s)

LUBKE ET AL.

Examiner

JAMES PILKINGTON

Art Unit

3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Prosecution Application

The RCE filed on July 27, 2009 is acceptable and an action on the RCE follows.

Drawings

The drawings are objected to under 37 CFR 1.83(a) because they fail to show the structural detail including the connection between components and arrangement of the structure in the device as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). It currently appears that drawing is showing a schematic of the device in various operation arrangements and not the structure and the structural relations being claimed.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The amendments filed 3/09/09 and 7/27/09 are objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- In the amendment of 3/09/09: The rotational axle being perpendicular to the groove (amendment made on page 4 line 2 of marked up specification filed 3/09/09), the specification only contained support for a parallel arrangement as disclosed in the specification and since the drawings do not show any detail of the device a particular arrangement can not be determined.
- In the amendment of 7/27/09: Paragraph 24 of the specification originally stated in lines 1-3 "the rotational axle for the rocker element, which axle is located symmetrically beside the groove" and has been amended to state "a rotational axle for the rocker element, which axis is located within the respective groove" (in the specification amendment filed 7/27/09). There was no support in the original filing for the axle (axis) to be located within the groove.

Applicant is required to cancel the new matter in the reply to this Office Action.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 10 lines 2-3 "the rocker element is asymmetrically placed with reference to the corresponding groove." There is not proper antecedent basis for the term "asymmetrically."

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for all the structure being claimed, does not reasonably provide enablement for the relationship/connection between the structure in the device. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. For example the specification, drawings or claims do not disclose the following: How is the selection finger arranged relative to the grooves so that it engages the grooves? What are the wedge-shaped tips, are these part of the grooves? How is the compression spring arranged relative to the device to exert a force on the wedge-shaped tips? How is the neutral groove bound to each gear stage?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites "a plurality of grooves each having at least one rocker element", "a respective spring" and "a first wedge-shaped tip." Since claim 12 depends from claim 9 it is not clear if these are the same grooves, rocker element, spring and wedge-shape tip. Are these additional element to those recited in claim 9 or is the Applicant referencing the same elements?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-14, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Bart, DE19543645.

Bart disclose a shift device for a transmission with a cam drive comprising a shifting roll (10) rotatably guided on an axle (11) and having grooves (7, 8, 9, 16) in an exterior surface, a selection finger (4, 5, 6, 17) which engages the grooves, a plurality of rocking elements (edges of grooves) rotatable supported by the axle, wherein the rocker

elements are located proximate an outer circumference of the shift roll and each rocker elements is provided on each respective end thereof with a wedge shape (slopes of grooves) tip and a compressions spring (15) placed on one side of the rotatable axle to exert a force on the wedge-shaped tips (exerts force by biasing fingers against a wall of the grooves), wherein a neutral groove is bound to each groove, wherein each groove comprises a plurality of neutral groove portions and at least one gear stage groove portion (neutral is between different gear stages within the shift assembly) and a pair of neutral groove portions are located on each side of the at least one gear stage groove portion.

Claims 9 and 14 contain functional language which only describes how the device is intended to operate. The way device functions does not structurally differentiate the device over the prior art, see MPEP 2114. The phrase "so that the shift device is a passive speed of rotation regulated system, and a choice of a desired gear stage for upshifting as well as downshifting is achieved as a function of a speed of rotation of the shifting roll relative to centrifugal force and as position of the rocker elements" does not structurally limit the claim.

Response to Arguments

Applicant's arguments filed 7/27/09 have been fully considered but they are not persuasive.

In response to the comments made in the Advisory Action dated July 16, 2009 the Applicant argues that the "Figure 1 clearly shows the rocker element pivotably supported on the exterior surface of the roller 7 within one of the respective grooves G."

Since Figure 1 is only a schematic representation with all the structure being represented by either a circle, line or box any structural relationships and interconnections can not be determined. The Applicant has provide an exhibit drawing to better illustrate the structural relations however this does not correct of deficiency in the original drawing and/or specification.

The Applicant argues that the amended drawing introducing additional reference characters to Figure 1 corrects the drawings and shows the structural details.

The addition of reference characters does introduce the structural relationships being claimed to the drawings. The claims address particular arrangements of springs, rocker elements, wedge-shaped tips etc. which is not adequately depicted in a schematic representation of an apparatus. Exhibit A appears to be showing some of the structural features required to properly understand the invention, however, this arrangement was not discussed in any detail in the original specification and appears to show spring 9 under element 8 which does not appear to be the case when viewed in Figure 1.

The Applicant argues that use of the term "perpendicular" is the adequate disclosure of the invention and not parallel as originally filed and should not be

considered new matter. To support this position the Applicant relies on Exhibit A as the supporting evidence.

As original filed the specification stated that the arrangement was parallel and not perpendicular. Since the only Figure provided shows a schematic representation of the device which does not depict a particular arrangement of the elements the only support for the arrangement is the original specification. The addition of the Exhibit drawing does not correct the original specification and drawing.

The Applicant argues the rejection under 35 USC 112 1st paragraph with a detailed description on how the device functions in relation to Figure 1.

The schematic does not show the structural relation between the elements. One of ordinary skill in the art could not make or use the device based on the schematic representation provided by the Applicant and the specification, as originally filed, does not disclose any detailed arrangement of the components. For example, the following details were not disclosed at the time of filing: How are the rocker elements attached on individual rotatable axles and where are these axles in relation to the rest of the device? How are the springs attached to the rocker elements?

The Applicant argues that Bart does not disclose the "pivotable rocker elements" as claimed.

The claims do not recite any structure of the pivot connection of the rocker elements. The claims only require that the rocker arms be pivotable. In Bart the rocker

elements are the edges of the grooves which have slopes (wedges) which divert the selector finger. Since the grooves, of which the rocker elements are a part of, pivot about the rotational axis 11 the rocker elements are also pivotable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES PILKINGTON whose telephone number is (571)272-5052. The examiner can normally be reached on Monday - Friday 7-3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/562,028

Page 10

Art Unit: 3656

/Thomas R. Hannon/

Primary Examiner, Art Unit 3656